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OFFICE OF PETITIONS

In re Application of
Yokio Isobe et al.
Application No. 09/757,802
Filed: January 9, 2001
Attorney Docket No. 16869S-019500US

ON PETITION

This is a decision on the petition filed July 30, 2001, requesting that the above-identified application be accorded a filing date of January 9, 2001. The petition is being treated under 37 CFR 1.182.

After the application was filed, the Office of Initial Patent Examination mailed a "Notice of Incomplete Application Papers" on April 24, 2001, *inter alia*, stating that no filing date had been assigned because the application was deposited without drawings. The "Notice" set a two (2) month period for response and advised that the filing date would be the date of receipt of the drawings or that by petition, it could be asserted that the drawings had been previously submitted or that the drawings were not necessary.

In response, on July 30, 2001 with a one month extension of time, petitioner filed a response to the "Notice" which included a copy of the drawings and the instant petition arguing that the application claims priority to Japanese Patent Application 2000-006062, filed January 11, 2000 and that the disclosure of which was incorporated by reference. A copy of the certified priority document was included with the petition.

The application was accorded the filing date of the petition and the drawings received on July 30, 2001.

Petitioner argues that the application should be entitled to the original filing date of January 9, 2001 based on the express incorporation by reference.

It is noted that the application transmittal did in fact note and incorporate by reference Japanese Patent Application 2000-006062, filed January 11, 2000, however according to a review of the application file by the Examiner of Record, the drawings in the Foreign Priority document filed on even date with the instant

application are different from the drawings in Japanese Patent Application 2000-006062, filed January 11, 2000. Therefore, the drawings, as described in the specification, was not a part of the disclosure of the prior application and thus is considered new matter.¹

It is however the USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).² A review of the record reveals that the application contains at least one method claim. Therefore, the present application is deemed to be an application which does not require a drawing for an understanding of the invention. Accordingly, the application, as filed, is entitled to a filing date.

The petition is **GRANTED**.

The "Notice of Incomplete Nonprovisional Application" mailed on April 24, 2001, 2003, was sent in error and is hereby **VACATED**.

The application is being forwarded to the Office of Patent Application Processing for a correction of the filing date to January 9, 2001 and for an indication on the bib-data sheet that no sheets of drawings were present on filing.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.



Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

¹MPEP 201.06(c) states that:

... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

²MPEP 601.01(f).